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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/542,013

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Jun Fujita

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OLIFF & BERRIDGE, PLC
P.O. BOX 320850
ALEXANDRIA, VA 22320-4850

EXAMINER

SCHATZ, CHRISTOPHER T

ART UNIT

PAPER NUMBER

1791

MAIL DATE

DELIVERY MODE

08/18/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/542,013	Applicant(s) FUJITA ET AL.	
	Examiner CHRISTOPHER SCHATZ	Art Unit 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 4,6,7,9 and 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5 and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/16/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Species A2 and Species B2, drawings to claims 1-3, 5 and 8 in the reply filed on 06/01/2009 is acknowledged. The traversal is on the ground(s) that examination of the separate Species would not present a search burden to the examiner. This is not found persuasive because each of the species are mutually exclusive embodiments. Because they are mutually exclusive, the examiner would be required to perform a separate search for each embodiment. The applicant does not refute that the Species are mutually exclusive.

The requirement is still deemed proper and is therefore made FINAL.

Claims 4, 6, 7, 9 and 10 are withdrawn from examination as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 3 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 3 recites the limitation "the adhesive member" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 1-3 are rejected under 35 U.S.C. 102(a) as being anticipated by the applicant's Admitted Prior Art .

The applicant's Admitted Prior Art discussion discloses a method of manufacturing a honeycomb structure 3 having honeycomb segments 2 of a prism shape provided with numerous circulation holes (specification, page 2, lines 7-13), the method comprising: a masking step of attaching masking materials to both end surfaces of the honeycomb segments (specification, page 2, lines 14-16); a stacked body bonding step of bonding the honeycomb stacked body by bonding the plurality of honeycomb segments together while interposing adhesive layers therebetween (page 2, lines 17-20); an adhesive layer drying step of integrally fixing the honeycomb stacked body by heating and drying the adhesive layers (page 2, lines 21-24); a masking material separating step of separating the masking materials (page 2, line 30 – page 3, line 8); a grinding step of grinding an outer peripheral portion of the honeycomb stacked body into a predetermined shape (page 2, lines 25-29); and a coating material 4 applying and drying step of forming a coating material layer by applying a coating

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material to the outer peripheral portion of the honeycomb stacked body and then drying the coating material layer (page 2, lines 25-29).

As to claim 2, the Admitted Prior Art discussion discloses such (figure 2c).

As to claim 3, applicant's Admitted Prior Art discussion discloses an adhesive member comprising a base sheet and a sticky agent attached to one side of the sheet wherein the adhesive member is bonded to the end surface of the honeycomb segment through the sticky agent (page 3, lines 9-13).

6. Claims 1-3 are rejected under 35 U.S.C. 102(a) as being anticipated by JP 2002-126427 (herein referred to as '427).

'427 discloses a method of manufacturing a honeycomb structure 3 having honeycomb segments 2 of a prism shape provided with numerous circulation holes 31, the method comprising: a masking step of attaching masking materials to both end surfaces of the honeycomb segments (section 13 of machine translation); a stacked body bonding step of bonding the honeycomb stacked body by bonding the plurality of honeycomb segments together while interposing adhesive layers therebetween (section 13); an adhesive layer drying step of integrally fixing the honeycomb stacked body by heating and drying the adhesive layers (section 13, 34); a masking material separating step of separating the masking materials (section 20); a grinding step of grinding an outer peripheral portion of the honeycomb stacked body into a predetermined shape (sections 35-40); and a coating material 4 applying and drying step of forming a coating material layer by applying a coating material to the outer peripheral portion of the honeycomb stacked body and then drying the coating material layer.

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As to claims 2 and 3, '427 discloses such (section 16)

7. Claims 1-3 are rejected under 35 U.S.C. 102(a) as being anticipated by JP 2002-126421 (Norihiro, cited in IDS, herein referred to as '421).

'421 discloses a method of manufacturing a honeycomb structure 3 having honeycomb segments of a prism shape provided with numerous circulation holes, the method comprising: a masking step of attaching masking materials to both end surfaces of the honeycomb segments; a stacked body bonding step of bonding the honeycomb stacked body by bonding the plurality of honeycomb segments together while interposing adhesive layers therebetween; an adhesive layer drying step of integrally fixing the honeycomb stacked body by heating and drying the adhesive layers; a masking material separating step of separating the masking materials; a grinding step of grinding an outer peripheral portion of the honeycomb stacked body into a predetermined shape; and a coating material 13 applying and drying step of forming a coating material layer by applying a coating material to the outer peripheral portion of the honeycomb stacked body and then drying the coating material layer (sections 8-10, 13-15, figures 1, 2, 4). Additionally, the reference discloses covering the outer peripheral portion of the honeycomb with the masking material. As to claim 2, the reference discloses such. As to claim 3, '421 discloses a base material (adhesive sheet) and a sticky agent on the adhesive bonded to said end surface of the honeycomb segment.

Claim Rejections - 35 USC § 103

8. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over '421, as applied to claim 1 above, and in view of Rowland (US 5535355).

'421 discloses that masking material is removed from the end of the honeycomb segment, but it is not clear if the reference discloses a method wherein the masking material is subjected to brushing during the masking material removing step. Rowland discloses a method of removing a material adhered to a surface via an adhesive, wherein said material layer is subjected to brushing during the material layer removing step. At the time the invention was made it would have been obvious to one of ordinary skill in the art to modify the method of '421 by subjecting the masking material to brushing during the removal step as taught by Rowland above as doing such is an efficient method of removing adhesive bound layers from surfaces (column 2, lines 32-29).

9. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over '427, as applied to claim 1 above, and in view of Rowland (US 5535355).

'427 discloses that masking material is removed from the end of the honeycomb segment, but it is not clear if the reference discloses a method wherein the masking material is subjected to brushing during the masking material removing step. Rowland discloses a method of removing a material adhered to a surface via an adhesive, wherein said material layer is subjected to brushing during the material layer removing step. At the time the invention was made it would have been obvious to one of ordinary skill in the art to modify the method of '427 by subjecting the masking material to

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brushing during the removal step as taught by Rowland above as doing such is an efficient method of removing adhesive bound layers from surfaces (column 2, lines 32-29).

10. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over '427 or '421, as applied to claims 1 and 3 above, and in view of Frost (US 5021204).

It is not clear if '427 and '421 disclose a method wherein the base sheet is made from a heat shrinkable material that shrinks during the drying step. Frost discloses a method of end sealing a cylindrical honeycomb structure with an adhesive base sheet 23, 24, and further discloses that it is well known in the art to use a heat shrinkable sheet as an alternative (column 10, lines 56-60). At the time the invention was made it would have been obvious to one of ordinary skill in the art to modify the method of '427 or '421 by using a heat shrinkable film that shrinks during heating as taught by Frost above as such is a well known alternative in the art.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER SCHATZ whose telephone number is 571-272-6038. The examiner can normally be reached on Monday through Friday 9 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CHRISTOPHER SCHATZ/
Examiner, Art Unit 1791

/Richard Crispino/
Supervisory Patent Examiner, Art Unit 1791